



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,001	01/16/2004	Eugenio Cruz Garcia	5724.012.21-US	5034
30827	7590	01/31/2006	EXAMINER	
MCKENNA LONG & ALDRIDGE LLP 1900 K STREET, NW WASHINGTON, DC 20006			SLACK, NAKO N	
			ART UNIT	PAPER NUMBER
			3635	
DATE MAILED: 01/31/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,001

Applicant(s)

GARCIA, EUGENIO CRUZ

Examiner

Naoko Slack

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

In view of applicant's amendment received November 7, 2005, amendments to the claims have been entered. The substitute specification filed January 25, 2005 has been entered and obviates changes to the drawings as stated in the previous office action. Claims 1-3 have been canceled. An examination of pending claims 4-12 follows.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 4 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,688,061. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 1 of US Patent 6,688,061 corresponds to claim 4 of the application.

Specification

The disclosure is objected to because of the following informalities: the specification lacks continuity data of applicant's previous applications and subsequent patents. Continuity data must be disclosed in the first paragraph of the specification.

Appropriate correction is required.

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "a" has been used to designate both "a deformity" (Figure 2) and "a rim edge" (Figure 3). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 10, it is not understood how the visual pattern on the surface of the product may extend into the edge contour. Specifically, claim 10 depends from claim 4 which states that the product is mechanically pressed and cut, and includes an edge contour machined on the perimeter of the product. Machining of an edge contour would remove the patterned layer at the top edge surface of the product. Furthermore, this feature is not disclosed in the specification to enable one of ordinary skill to make it. Clarification or deletion of this claim is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6, 146,252 to Martensson in view of French Patent 1,489,710 to Formica.

Claims 4, 5-9, 11, 12:

Martensson discloses a laminated material comprising cellulose sheets impregnated with resin that are mechanically pressed and cut into a product (column 3,

Art Unit: 3635

lines 21-44 and claims 15-19). The product includes a surface with a machined edge contour (14 and 18, Figure 2 and column 1, lines 21-28) and an interior region (top surface of 13, Figure 2), wherein the edge contour lies below the interior region. While the edge contour is shown to have a substantially linear cross-sectional shape from the interior region to an edge of the product (14, Figure 2), Martensson discloses that the edge contour may also have smooth edges, as in forming curved grooves and tenons for floor boards that are joined side by side (column 1, lines 21-28). The laminate also comprises one patterned sheet (column 3, lines 26-28). Since the patterned sheet is laminated as a layer of the product prior to edge contouring, the pattern will not extend into the edge contour.

While Martensson does not disclose surface texturing on the upper surface of the panel that varies in accordance with an underlying visual pattern, texturing of the surface of floor boards to follow an underlying patterned layer is well known in the art. Formica discloses a floor panel with an upper surface of floor panel having impressions (8, Figure 5) extending from the upper top side of the panel into a resin-soaked decorative cellulose layer, wherein said impressions substantially follow the printed wood pattern (10, Figure 5) on the cellulose layer to form an embossment which is in register with the printed wood pattern (page 3, column 1, last paragraph, lines 5-8). Formica's floor panel is a direct pressure laminate (page 3, column 1, last paragraph, line 4).

In view of Formica, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the top surface of Martensson's floor panel

Art Unit: 3635

with impressions that follow the underlying wood decor to enhance the realistic effect of a wood grain décor.

It is noted that applicant's claims are drawn to a laminate product, not to a method of manufacture. Applicant's claims pertaining to the method of manufacture do not further limit structural features of a product claim and therefore are not considered. Specifically, method of manufacturing steps include: "cellulose sheets... that are mechanically pressed and cut into a product"(claim 4, lines 1-2), "the surface is mechanically formed" (claim 4, line 5), "wherein the edge contour is machined" (claim 4, lines 7), "the machining of the edge contour comprises mechanical scraping" (claim 7), "the machining of the edge contour comprises milling (claim 8), and "the machining of the edge contour comprises cutting" (claim 9).

Prior Art Made of Record

US Patent 5,766,752 to Cox et al. and US Patent 6,709,764 to Perrin et al. disclose cellulose laminate products.

US Patent 5,034,272 to Lindgren et al. discloses cellulose sheets impregnated with resin to produce floor boards

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naoko Slack whose current telephone number is 571-272-6848. The examiner can normally be reached on Mon-Fri (6:00 am-2:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 571-272-6842. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naoko Slack
Primary Examiner
Art Unit 3635

NS
January 20, 2006